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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHONG SENG CHENG

Appeal 2012-011075¹
Application 09/803,173
Technology Center 2100

Before JEAN R. HOMERE, ST. JOHN COURTENAY III, and CARLA M. KRIVAK *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The real party in interest is Trek Technology Pte. Ltd. (App. Br. 1.) In Appeal 2008-006002, dated 11/20/09, an earlier panel affirmed the Examiner's rejections of claims 22-30. An oral hearing was held in this appeal on November 5, 2012.

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 22-24 and 26-30. Claims 1-21 and 25 have been canceled. (App. Br. 2.) We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellant's Invention

Appellant invented a unitary portable storage device capable of being directly plugged into a universal serial bus (USB) of a computer via a USB connector. In particular, the portable storage device includes a non-volatile solid state memory containing a memory storage space as large as that of a magnetic disk or a compact disk (CD) thereby allowing the portable storage device to serve as an alternative to the magnetic disk or CD. (Spec. ¶¶ [0002], [0004], [0006], [0018].)

Illustrative Claim

Independent claim 22 further illustrates the invention as follows:

22. A unitary portable data storage device which can be directly plugged into a universal serial bus (USB) socket of a computer and which is operative to function as an alternative to a magnetic disk or compact disk (CD), and which is capable of storing software for installation to the computer or of receiving and storing user's data present in the computer, the unitary portable data storage device comprising:

a USB plug integrated into the unitary portable data storage device without an intervening cable capable of coupling the unitary portable data storage device directly to a USB socket on a computer;

an interface allowing the unitary portable data storage device to communicate via the USB protocol and being coupled to the USB plug;

a non-volatile solid-state memory, said memory being non-removable from the unitary portable data storage device and having a memory space at least as large as the memory space of a magnetic disk or CD to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD; and

a memory controller, the memory controller being coupled between the interface and the memory to control storage of data received via the USB plug in the memory in a manner to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD, the data including at least user data that is not authorization data.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Jha	US 6,407,949 B1	Jun. 18, 2002
Margalit	US 6,748,541 B1	Jun. 8, 2004

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

1. Claim 22 stands rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.
2. Claim 22 stands rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and

distinctly claiming the subject matter which Appellants regards as the invention.

3. Claims 22-24 and 26-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Margalit.

4. Claims 29 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Margalit and Jha.

ANALYSIS

We consider Appellant's arguments² *seriatim* as they are presented in the Appeal Brief pages 5-15 and the Reply Brief pages 2-26.

Written Description Rejection

Dispositive Issue 1: Has Appellant shown the Examiner erred in finding that claim 22 fails to comply with the written description requirement under § 112 first paragraph?

Appellant argues the Examiner erred in concluding that the limitation of a portable data storage device having a memory space at least as large as the memory space of a magnetic disk or CD is not adequately supported by Appellant's original disclosure. In particular, Appellant submits that one of ordinary skill in the art would have recognized the recitations of (1) surface-

² Appellant's request to correct the inventorship of the present application to add inventor Teng Pin Poo thereto was not properly brought before us. (App. Br. 4.) Because this request is directed to a petitionable, and not an appealable matter, we do not have jurisdiction upon such matter. Therefore, we decline Appellant's invitation to address the merit of this request in this Opinion.

based storage devices being limited because they are generally bulky and have moving parts; (2) a user may utilize the USB device to increase memory space if desired; and (3) the flash memory is capable of being divided into zones for storing user's data, adequately support the disputed limitation. (App. Br. 6-7.)

In response, the Examiner finds the cited portions of the Specification disclose at best a portable storage device that overcomes the deficiencies of traditional storage devices by serving as an additional memory space which does not have movable parts. However, the Examiner finds the cited portions of the Specification in no way support the limitation that the portable device has a memory space at least as large as that of a magnetic storage device or a CD. (Ans. 12-14.)

On the record before us, we find no error in the Examiner's finding that the cited claim fails to comply with the written description requirement. To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail such that one skilled in the art can reasonably conclude the inventor had possession of the claimed invention. *See, e.g., Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 1563 (Fed. Cir. 1991).

However, a showing of possession alone does not cure the lack of a written description. *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 969 (Fed. Cir. 2002). Much of the written description case law addresses whether the specification as originally filed supports claims not originally in

the application. The invention claimed does not have to be described in *ipsis verbis* in order to satisfy the written description requirement. *Union Oil Co. v. Atlantic Richfield Co.*, 208 F.3d 989, 1000 (Fed. Cir. 2000). However, one skilled in the art, reading the original disclosure, must be able to immediately discern the limitations now claimed. *See Waldemar Link, GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 558 (Fed. Cir. 1994) (“The fact finder must determine if one skilled in the art, reading the original specification, would immediately discern the limitation at issue in the parent.”).

Appellant’s Specification states the following:

The second type of device is surface based data storage devices in which data is stored, typically, on the surface of a disk or tape. Examples of surface storage devices are magnetic disks and CD ROMs. Such data storage devices require a mechanical drive mechanism to be installed in or coupled to the computer to permit the data on the storage device to be read by the computer. In addition, such memory devices are limited by the surface area of the storage device, and the combination of the storage device and the drive mechanism for reading data from the storage device is generally bulky and/or delicate due to the moving parts that are required within the drive mechanism and/or storage device.

(Spec. ¶ [0004].)

The preceding portion of Appellant’s Specification indicates that magnetic disks or CD ROMs are known to have moving parts that usually require the use of bulky and delicate storage and drive mechanisms to read such devices.

Appellant’s Specification further states:

An advantage of the invention is that by providing a portable data storage device comprising a coupling device with an interface device, memory control device and a non-volatile solid-state memory device, it is possible to provide a portable data storage device which may be coupled to a computer having a serial bus port and which does not include moving parts or require a mechanical drive mechanism to read the data from the data storage device.

(Spec. ¶ [0006].)

The preceding portion of Appellant's Specification indicates that because portable storage devices can be coupled to the computer via a USB port, they do not have movable parts that require bulky mechanical drive mechanisms to read the portable device.

Appellant's Specification also states:

The flash memory 4 is typically divided into a number of different sections or zones. Typically, the flash memory is divided into two zones and each zone has a unique password. If the data storage device 10 is supplied with packaged software, the software serial number can be set in one zone to be the password to permit a user to access and use the software. The other zone, which can be used typically for storing a user's data, may have a separate password which is set by the user.

(Spec. ¶ [0020].)

The preceding portion of the Specification indicates that the portable memory can be divided into zones to store a user's data including the user's password.

Additionally, Appellant's Specification states:

The device 10 also includes a USB socket 8 that is coupled directly to the USB plug 1 and permits other USB devices to be

coupled to the USB via the device 10. For example, if a user wishes to increase memory space, a USB plug 1 of a second memory device 10 may be connected to the USB socket 8.

(Spec. ¶ [0022].)

The preceding portion of the Specification indicates that the portable storage device can be used to increase the memory space available to the user.

We agree with the Examiner that the afore cited portions of Appellant's Specification at best disclose a portable storage device that does not require the bulky drive mechanisms of conventional storage devices to be read by a computer, and that the portable storage device can be coupled to a computer as an additional drive to store user's data. Therefore, to the extent that the portable storage device does not require bulky drive mechanisms to read the conventional storage drives, the Specification does *imply* that the device can serve as a viable alternative to conventional storage drives.

However, we find that the silence of the Specification regarding the size of the portable device simply does not support Appellant's argument that the portable device has a memory storage space *at least as large* as that of a magnetic disk or CD. We find that, in light of this silence, a great deal of conjecture would be required for the ordinarily skilled artisan to surmise from the cited portions of the Specification that the portable device has a memory space as characterized in the claim. Our reviewing court guides "[a] description which renders obvious the invention for which an earlier filing

date is sought is not sufficient.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). One shows “possession” by descriptive means such as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood*, 107 F.3d at 1572. *It is not sufficient for purposes of the written description requirement that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose. Lockwood* 107 F.3d at 1572 (quoting *Jepson v. Coleman*, 314 F.2d 533, 536 (CCPA 1963)). “[I]t is ‘not a question of whether one skilled in the art *might* be able to construct the patentee’s device from the teachings of the disclosure. ... Rather, it is a question of whether the application *necessarily* discloses that particular device’” (*id.*) (emphasis added).

Appellant’s attempt to utilize extrinsic evidence to bridge gaps noted in the Specification simply falls short of the intended mark. In particular, Appellant argues that “[t]o serve as an effective replacement for magnetic disks and CD ROMs, the claimed portable data storage device *must* have a memory space that is at least as large as a magnetic disk or CD-ROM.” (App. Br. 6) (citing to Mr. Hyde’s Affidavit.) (Emphasis added). As discussed above, we find that to the extent the Specification indicates the portable device serves as an alternative to the magnetic disk or CD ROM, it is limited to the fact that the portable storage device does not require the bulky drive mechanisms of conventional disks. However, such alternative has no bearing upon the size of the portable storage device as supported by

Appellant's original disclosure. Therefore, we do not agree with Appellant that the alternative portable storage device must necessarily have a memory storage space as large as that of a magnetic disk or CD. Consequently, we agree with the Examiner that the cited disclosure does not describe the disputed limitation in sufficient detail to thereby apprise the ordinarily skilled artisan that Appellant possessed the claimed subject matter at the time of the invention. It follows that Appellant has not shown error in the Examiner's rejection of claim 22.³

Indefiniteness Rejection

Dispositive Issue 2: Has Appellant shown the Examiner erred in concluding that claim 22 is indefinite under § 112 second paragraph?

Appellant argues the Examiner erred in concluding that the limitation of a portable data storage device having a memory space at least as large as the memory space of a magnetic disk or CD renders claim 22 indefinite. In particular, Appellant argues that while the capacity of the magnetic disk can vary, such variation in size does not render the claim indefinite because one of ordinary skill in the art would have been able to pick an appropriate size of the magnetic disk depending on the situation. (App. Br. 8). Further, Appellant reiterates that because the portable storage device serves as an

³ We note that the Examiner rejected independent claim 22 under § 112 while omitting claims 23, 24, and 26-30 depending therefrom. However, the dependent claims do not cure the noted deficiencies of claim 22. Because claims 23, 24, and 26-30 incorporate the deficiencies of independent claim 22 by dependency, they are also rejected under § 112, first paragraph for failing to comply with the written description requirement.

alternative to the magnetic disk or CD, one of ordinary skill would understand that it must necessarily be as large as the magnetic disk. *Id.* We find these arguments unavailing.

During prosecution before the USPTO “if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.” *Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (“Precedential”). As discussed above, the portable storage device alternative does not necessarily imply that the device has a size *at least as large* as that of the magnetic disk because the portable device is only an alternative from the standpoint of its ability to be externally coupled to the computer without the need for a conventional bulky drive reading mechanism of conventional magnetic disks or CD ROMs. Further, because the scope of the claim does not particularly apprise the ordinarily skilled artisan of a particular size of the magnetic disk to pick from among the various sizes thereof at the time of the invention, the artisan would not be able to ascertain the scope of the claim. That is, the claimed portable storage device could reasonably be construed, at the time of the invention, as having the size of a magnetic disk (e.g., 1.44MB) or having the size of a second magnetic disk (2.88MB) (Hyde Affidavit, ¶13.). Therefore, we agree with the Examiner that the scope of the claim is indefinite as the storage size of the portable device can have more than one plausible interpretation. It follows that Appellant has not shown error in the Examiner’s rejection of

claim 22 as being indefinite. Dependent claims 23, 24, and 26-30 are similarly indefinite for the same reasons.⁴

Prior Art Rejections

Dispositive Issue 3: Has Appellant shown the Examiner erred in finding that Margalit describe *a portable data storage device having a memory space at least as large as the memory space of a magnetic disk or CD ROM*, as recited claim 22?

Appellant argues the Examiner erred in finding that Margalit describes the disputed limitations emphasized above. In particular, Appellant argues that Margalit discloses a smart card having a storage device containing a user's authentication information for allowing the user to access a host computer or network. However, Margalit's storage device is not as large as that of a magnetic disk or a CD ROM. (App. Br. 10-12.)

In response, the Examiner concludes that under the broadest reasonable interpretation, the size of the magnetic disk can be construed as to store "a byte or even a bit" (Ans. 18). Consequently, the Examiner finds that Margalit's disclosure of storage device for storing user's data describes the disputed limitations (Ans. 17-18).

On the record before us, we conclude the Examiner erred in the finding of anticipation. First, we find persuasive Mr. Hyde's Affidavit that at the time of the invention the minimum size of a magnetic disk or a CD ROM was 1.44 megabytes (Affidavit ¶ 13); whereas memory smart cards only had up to 1 kilobyte of memory space. (*Id* at ¶ 21; Reply Br. 13). In light of this

⁴ See supra note 3.

persuasive evidence, we find unreasonable the Examiner's claim construction limiting the size of the magnetic disk as being capable of storing only a single bit. Accordingly, we find that at the time of the invention Margalit's memory smart card would at best be up to 1 kilobyte in size, which is far below the 1.44 megabyte minimum storage capacity of a magnetic disk or CD ROM around that same time. Therefore, the size of Margalit's smart drive does not describe the claimed magnetic drive or CD. Because Appellant has shown at least one error in the Examiner's rejection of claim 22, we need not reach Appellant's other arguments.

Appellant has similarly shown error in the Examiner's rejection of dependent claims 23, 24, and 26-28. Regarding the rejection of claims 29 and 30, we find similar error as noted above, and we further find that Jha does not cure the noted deficiencies. Therefore, Appellant has also shown error in the Examiner's rejection of those claims.

DECISION

We affirm the Examiner's § 112 first and second paragraph rejections of claims 22-24, and 26-30. However, we reverse the Examiner's prior art rejections of claims 22-24 and 26-30 as set forth above.

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2012-011075
Application 09/803,173

AFFIRMED

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